

REMARKS

Claims 1-10 are pending in this application, of which claims 1 and 9 are independent. Claims 3, 4, 7 and 9 have been amended to correct typographical and grammatical errors. Care has been taken to avoid the introduction of new matter.

In the Office Action, claims 1-10 were rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent 6,983,656 B2 (Cullum). Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent 5,189,912 (Quinlan). Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Quinlan in view of US Patent 6,122,957 (Bux). Claims 7-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Quinlan in view of US Patent 6,484,574 B1 (Douglas). Claims 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Quinlan in view of Bux and Douglas. These rejections are respectfully traversed. Applicant hereby requests reconsideration and allowance of the claims in view of the following arguments.

Regarding the anticipation rejection of independent claims 1 and 9 based on Cullum, this reference does not disclose or even suggest claim 1's step of determining at least one balancing plane associated with the best matching rim or wheel. Furthermore, Cullum does not disclose or suggest claim 9's memory in which information related to balancing planes associated with rims and wheels are stored, or claim 9's processor for determining at least one balancing plane associated with a best matching rim or wheel. Rather, Cullum determines a type of corrective weight to be used based on a determined rim edge (see, e.g., Cullum at col. 9:15-17). In other words, the claimed invention links a balancing plane with a certain rim or wheel, while Cullum links a type of corrective weight to a certain rim or wheel. Moreover, Cullum assumes that the corrective weight is to be attached to an edge of a rim. Therefore, Cullum does not need to

determine a balancing plane, as claimed. The balancing plane in Cullum is a constant; i.e., the edge of the rim.

Thus, Cullum does not anticipate independent claims 1 or 9, because it does not disclose each and every element of those claims, and it would not have been obvious to modify Cullum's device to yield the inventions of claims 1 and 9.

Consequently, claims 1 and 9 are patentable over Cullum, as are claims 2-8 and 10, which depend from claims 1 and 9, respectively.

Further regarding dependent claim 6, Cullum does not teach or even suggest the claimed step of altering the axial position of a balancing plane on which an optical scanning beam of a scanning device is directed, for marking the altered axial position, wherein the angular position and the size of the balancing weight are calculated based on the altered axial position. Cullum does not mention a balancing plane, or alteration of a balancing plane. Therefore, claim 6 is further and separately patentable.

Further regarding dependent claims 7 and 8, Cullum does not teach or even suggest the claimed steps of storing data related to detected contour features of a rim with an axial position of at least one associated balancing plane, and using the stored data for balancing vehicle wheels of other vehicles of the same or a similar type. Cullum does not link rim features to a balance plane, despite contentions to the contrary in the Office Action. Note that the tables of Cullum cited at page 4 of the Office Action to support the rejection of claims 7 and 8 link dimensions of wheel rim edges with types of corrective weights, not with balance planes. Thus, claims 7 and 8 are further and separately patentable.

Further regarding dependent claim 10, Cullum does not teach or suggest the claimed processor for ascertaining the axial position of a balancing plane of the best matching rim or

wheel, and calculating an angular position and a size of at least one balancing weight to be attached to the ascertained balancing plane. As discussed above, Cullum does not mention determining a balancing plane. Thus, it cannot teach or suggest ascertaining the axial position of a balancing plane. Therefore, claim 10 is further and separately patentable.

Regarding the anticipation rejection of independent claim 1 based on Quinlan, this reference does not disclose or even suggest claim 1's step of determining at least one balancing plane associated with the best matching rim or wheel. Rather, Quinlan teaches determining the *radius of a balance weight receiving location* based on a determined wheel profile (see, e.g., Quinlan at col. 6:39-44). Quinlan's "reference plane" discussed at col. 6:31-35 is not equivalent to the claimed balance plane. Quinlan's reference plane is an arbitrary plane that does not change (it is described, for example, at col. 10:39-40 of Quinlan as reference numeral 18 in Fig. 3) and is thus not determined based on a wheel or rim type, as recited in claim 1.

Thus, Quinlan does not anticipate independent claim 1, because it does not disclose each and every element of that claim, and it would not have been obvious to modify Quinlan's device to yield the invention of claim 1.

Consequently, claim 1 is patentable, as are claims 2-4, which depend from claim 1.

Regarding the obviousness rejection of dependent claims 5 and 6 based on Quinlan and Bux, the Bux reference does not furnish the step of independent claim 1, from which claims 5 and 6 depend, missing from Quinlan (i.e., the step of determining at least one balancing plane associated with the best matching rim or wheel). Therefore, any combination of Quinlan and Bux would still be missing this important claimed step, and it would not have been obvious to add this step to any Quinlan/Bux combination.

Consequently, claims 5 and 6 are patentable.

Further regarding claim 6, neither Quinlan nor Bux teaches or even suggests the claimed step of altering the axial position of a balancing plane on which an optical scanning beam of a scanning device is directed, for marking the altered axial position, wherein the angular position and the size of the balancing weight are calculated based on the altered axial position. Neither of these references mentions a balancing plane, or alteration of a balancing plane. Therefore, claim 6 is further and separately patentable.

Regarding the obviousness rejection of dependent claims 7 and 8 based on Quinlan and Douglas, the Douglas reference does not furnish the step of independent claim 1, from which claims 7 and 8 depend, missing from Quinlan (i.e., the step of determining at least one balancing plane associated with the best matching rim or wheel). Therefore, any combination of Quinlan and Douglas would still be missing this important claimed step, and it would not have been obvious to add this step to any Quinlan/Douglas combination.

Consequently, claims 7 and 8 are patentable.

Regarding the obviousness rejection of independent claim 9 based on Quinlan, Bux and Douglas, none of these three cited references discloses or even suggests claim 9's memory in which information related to balancing planes associated with rims and wheels are stored, or claim 9's processor for determining at least one balancing plane associated with a best matching rim or wheel. Rather, as discussed in detail hereinabove in relation to claim 1, Quinlan teaches determining the *radius of a balance weight receiving location* based on a determined wheel profile, and does not link a balancing plane with a wheel type, as claimed. Neither Bux nor Douglas furnishes the claimed memory or processor either. Since none of the cited references teaches the claimed memory or processor, any combination of Quinlan, Bux and Douglas would

still be missing these claimed features, and it would not have been obvious to add these features to any Quinlan/Bux/Douglas combination.

Consequently, claims 9 and 10 are patentable.

Further regarding dependent claim 10, none of the cited references teaches or suggests the claimed processor for ascertaining the axial position of a balancing plane of the best matching rim or wheel, and calculating an angular position and a size of at least one balancing weight to be attached to the ascertained balancing plane. As discussed above, none of the three cited references teaches determining a balancing plane. Thus, they cannot teach or suggest ascertaining the axial position of a balancing plane. Therefore, claim 10 is further and separately patentable.

Accordingly, it is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

Application No.: 10/765,275

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Michael A. Messina

Registration No. 33,424

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MAM:llg
Facsimile: 202.756.8087
Date: July 31, 2006

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as our correspondence address.**